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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/915,978

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Gabriel Beged-Dov

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04/27/2004

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

MILLER, BENA B

ART UNIT

PAPER NUMBER

3712

15

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/915,978

Applicant(s)

BEGED-DOV, GABRIEL

Examiner

Bena Miller

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07/07/03 and 02/17/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The examiner inadvertently responded to the applicant's response filed 02/19/03; therefore, the previous Office Action dated 10/22/03 has been withdrawn. Further, claims 6-12 will not be examined on its merits according to the claims cancellation in the amendment filed 07/07/03.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of flexible fingers disposed in a first circle on the second surface must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the plurality of flexible fingers disposed in a first circle on the second surface as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter, as now amended "a paper or plastic film", is not supported by the original specification and therefore, constitutes New Matter. It appears that the specification of the claimed invention discloses on page 7 "a paper or plastic tape 803 is disposed over the CD 101". Further, the specification fails to describe how the paper or plastic film is disposed over the recordable medium.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the paper or plastic film is disposed over the recordable medium.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adoma in view of McClung et al (WO 01/95984A1).

Adoma teaches in the figures most of the elements of the claimed invention. However, Adoma may not teach a plurality of fingers having a cantilever portion, a crooked portion, and a ridge portion attached to a first or second surface of a body whereby recordable disk medium is releasably coupled to the body. Adoma teaches on page 5 that clamping device 8 is constructed in a known manner so that the compact disk can be locked in the opening 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of fingers in the throwable implement of Adoma for the purpose of the retaining the compact disc.

Adoma fails to teach a plurality of flexible fingers on the second surface of the disk-shaped body. McClung teaches a flying a disc with a compact disc secured to the bottom of the disc body (fig. 2, 9A, 9B and 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the plurality of flexible fingers of Adoma on the second surface of the disk-shaped body as taught by McClung for the purpose of retaining the compact disc.

Claims 1-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adoma in view of Wyatt and McClung et al (WO 01/95984A1)

Adoma teaches in the figures most of the elements of the claimed invention. However, Adoma may not teach a plurality of flexible fingers having a cantilever portion, a crooked portion, and a ridge portion attached to a first or second surface of a body whereby recordable disk medium is releasably coupled to the body. Wyatt teaches base 14, for holding a compact disk, having a plurality of flexible fingers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of flexible fingers as taught by Wyatt for the clamping retention means of Adoma for the purpose releasably retain the disk more securely.

Adoma fails to teach a plurality of flexible fingers on the second surface of the disk-shaped body. McClung teaches a flying a disc with a compact disc secured to the bottom of the disc body (fig. 2, 9A, 9B and 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the plurality of flexible fingers of Adoma on the second surface of the disk-shaped body as taught by McClung for the purpose of retaining the compact disc.

Claim 14 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adoma.

Adoma teaches in the figures throwable implement comprising a disk-shaped body (fig. 1), a depression (3) and a plurality of flexible fingers (8). On the hand, given a different interpretation of the claim, Adoma may fail to teach a plurality of flexible fingers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of flexible fingers on the implement of Adoma for the purpose of retaining the compact disk.

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Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adoma.

Adoma teaches in the figures most of the elements of the claimed invention except for paper film disposed over the recordable medium. Adoma teaches a cover 5 that is disposed over a compact disc (It should be noted in fig. 2-4, cover 5 is disposed over compact disc 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a paper film disposed over the recodable medium of Adoma for the purpose of helping secure the compact disk.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Bena Miller  
Examiner  
Art Unit 3712

bbm  
April 19, 2004